



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1950  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,319	09/25/2001	Misako Suwa	826.1757	5814

21171 7590 02/06/2006

STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

FILIPCZYK, MARCIN R

ART UNIT PAPER NUMBER

2163

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/961,319

Applicant(s)

SUWA ET AL.

Examiner

Marc R. Filipczyk

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,5,6,9,10,12,13,16,17,19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,7,8,11,14,15,18 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This action is responsive to Applicant's RCE and amendment filed November 14, 2005.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/05 has been entered.

Claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-24 are pending.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2163

Regarding claims 1, 8, 15 and 22. The step of “reading as an image a document printed on a paper in which a note is taken” is indefinite. It is not clear if the note is taken before or after the image is read.

Regarding claims 23 and 24, the preamble “A method comprising” is indefinite. A method cannot perform computer steps without the use of a computer.

Further regarding claim 23, the term “allowing” is indefinite. Allowing does not include performing any function/step.

Regarding claims 4, 7, 11, 14, 18 and 21 depend from claims 1, 8 and 15 respectively, and therefore contain the deficiencies of those claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ching (U.S. Patent No. 6,533,168) in view of Takeda et al (U.S. Patent No. 4,748,678).

Regarding claims 1, 8, 15 and 22-24 Ching discloses a method, program and system for electronically managing a note taken in a paper document printed from an “electronic document

Art Unit: 2163

not including the note” (hereafter, original document) when the document is printed and used by a person, comprising: (figures 1a and 3, item 304, and col. 4, lines 9-14, Ching)

reading as an image a document printed on a paper in which a note is taken; (col. 4, lines 9-14, 17 and 18, Ching)

extracting information about the note from the read image of the document printed on the paper and a note handwritten on the paper; (col. 4, lines 9-14, Ching)

recognizing a character written in the image data of the note; (col. 10, lines 32-41, Ching)

searching (*purchaser*, fig. 9, item 903, Ching) contents of the electronic document and the recognition result (*database*, fig. 9, item 912, Ching) in accordance with a search keyword input from a user (*purchased request*, fig. 9), and displaying a search result; (fig. 1b, item 112 and fig. 9, Ching)

*(Note 1: database includes contents of electronic document and the recognition result, see support [col. 4, lines 14-24, lines 49-54, col. 10, lines 39-42 and col. 14, lines 3-9, Ching])*

*(Note 2: information is stored in database for retrieval/search)*

correlating and electronically storing the information about the note with the read image (col. 4, lines 14-17, and col. 10, lines 32-43, Ching) but does not explicitly teach correlating the original document with the information about the note and that the image data of the note is obtained by taking a difference between the original document and the read image.

However, Takeda teaches storing and retrieving image system that correlates an original document with information about a note (figures 7, 8, 11 and col. 9, lines 3-20, Takeda) and obtaining an image of the note by taking the difference between the original document and the read image (figures 7 and 8, Takeda).

Art Unit: 2163

Hence, having Ching system correlating information about the note with the read image (col. 10, lines 40-42, Ching), it would have been obvious to a person of ordinary skill in the art at the time the invention was made to correlate the information about the note with the original document as done in Takeda. One would have been motivated to store the correlation information about the note and the original document to keep track of the note and the related original document to avoid storing the read image which includes the original document with a note.

Further, having Ching system, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to obtain an image of the note by taking a difference between the original document (receipt) and the read image (receipt with note) as done in Takeda (figures 7 and 8, Takeda). One would have been motivated to take the difference between the receipt and the receipt with a note to exclusively store the image of the note for future processing.

*(Note: obtaining an image of the note by taking the difference between the original document and the read image is shown in fig. 7 and supported by location attributes in fig. 8 of Takeda)*

Regarding claims 4, 11 and 18, Ching/Takeda disclose the original document, a note image and a recognition result of the hand written note image are correlated and electronically stored (figures 7, 8, 11 and col. 9, lines 3-20, Takeda, see also [col. 4, lines 14-24, lines 49-54, col. 10, lines 39-42 and col. 14, lines 3-9, Ching]).

Art Unit: 2163

Regarding claims 7, 14 and 21, Ching/Takeda disclose location information of the note within the printed document (fig. 8, Takeda).

### ***Response to Arguments***

Applicant's amendment and arguments filed on November 14, 2005 have been fully considered but they are not persuasive. The arguments and responses are listed above.

Applicant argues on page 7 of the 11/14/05 response that the 35 U.S.C. section 112 par. 2 indefiniteness rejections have been overcome in the presently amended claims.

Examiner disagrees. The time of input of the note into the document is not clear in the claims. See rejections above.

Applicant argues on page 8 of the 11/14/05 response that Takeda and Ching do not teach searching contents of the database based on user input.

Examiner disagrees. Ching system clearly discloses a database wherein contents of documents and annotations wherein notes are taken are associated together are stored in database for later retrieval based on user search. Please see also [*col. 4, lines 14-24, lines 49-54, col. 10, lines 39-42 and col. 14, lines 3-9, and figures, Ching*).

No other arguments have been raised.

With respect to all the pending claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-24, Examiner respectfully traverses Applicant's assertion based on the discussion cited above.

Art Unit: 2163

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019.

The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF  
January 26, 2006

  
**FRANTZ COBY**  
**PRIMARY EXAMINER**